

Appln. No. 10/691,364
Docket No. GP-303400/GM2-0068

REMARKS / ARGUMENTS

Status of Claims

Claims 1-14 are pending in the application. Claims 1-9 and 11-14 are rejected. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates the Examiner's comments regarding the allowability of the noted claims. Applicant has amended Claims 1, 3, 7, 10, 13 and 14, and has canceled Claims 11 and 12, leaving Claims 1-10 and 13-14 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

These amendments and accompanying remarks were not presented earlier because Applicant did not fully appreciate the nature of the Examiner's position until the Applicant was advised of the position by the final rejection. The claim amendments presented herein, which Applicant respectfully requests entry thereof, should only require a cursory review by the Examiner as they include language presented in earlier allowed claims.

Rejections Under 35 U.S.C. §102(b)

Claims 7-9, 11, 12 and 14 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ito et al. (DE 3216820, hereinafter Ito).

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*" *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the *** claim."

Appln. No. 10/691,364
Docket No. GP-303400/GM2-0068

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, the single source must disclose all of the claimed elements "arranged as in the claim." *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

Applicant has amended Claims 7, 10, 13 and 14, and canceled Claims 11-12.

Claim 7 now recites, inter alia, "...the valve guide having inner and outer surfaces that define a thickness T... wherein the inner and outer surfaces of the valve shield define a thickness t; and wherein the thickness t is equal to or less than about 1/4 of the thickness T...".

Claim 10 has been amended for consistency of language and proper antecedent basis.

Claim 13 now recites, inter alia, "...the valve guide having inner and outer surfaces that define a thickness T... the valve shield having inner and outer surfaces that define a thickness t...wherein the thickness t is equal to or less than about 1/4 of the thickness T...".

Claim 14 now recites, inter alia, "...the valve guide having inner and outer surfaces that define a thickness T... wherein the inner and outer surfaces of the valve shield define a thickness t, the thickness t being equal to or greater than about 1/8 of thickness T and equal to or less than about 1/4 of thickness T...".

Support for the noted claim amendments may be found in originally allowed Claim 10 and in the specification as originally filed. No new matter has been added.

Dependent claims inherit all of the limitations of the respective parent claim.

Here, Applicant has amended the claims to include a structural relationship between the valve shield thickness t and the valve guide thickness T that is found in originally allowed Claim 10 and the specification as originally filed, and not disclosed in Ito.

Appln. No. 10/691,364
Docket No. GP-303400/GM2-0068

In view of the foregoing amendments and remarks, Applicant submits that Ito does not disclose each and every element of the claimed invention and therefore cannot be anticipatory. Accordingly, Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §102(b) has been traversed, and requests that the Examiner reconsider and withdraw of this rejection.

Rejections Under 35 U.S.C. §103(a)

Claims 1-6 and 13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ito in view of Matthews (U.S. Patent No. 5,592,913, hereinafter Matthews).

The Examiner acknowledges that Ito does not disclose a first clearance dimension and looks to Matthews to cure this deficiency. Paper 20041110, page 4.

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Applicant has amended Claims 1, 3 and 13.

Claim 1 now recites, inter alia, "...the valve guide having inner and outer surfaces that define a thickness T ... the valve shield having inner and outer surfaces that define a thickness t... wherein the thickness t is equal to or less than about 1/4 of the thickness T...".

Claim 3 now recites, inter alia, "...the thickness t is equal to or greater than about 1/8 of the thickness T."

Claim 13 now recites, inter alia, "...the valve guide having inner and outer surfaces that define a thickness T... the valve shield having inner and outer surfaces that

Appln. No. 10/691,364
Docket No. GP-303400/GM2-0068

define a thickness t ... wherein the thickness t is equal to or less than about $1/4$ of the thickness T ...".

Support for the noted claim amendments may be found in originally allowed Claim 10 and in the specification as originally filed. No new matter has been added.

Dependent claims inherit all of the limitations of the respective parent claim.

Here, Applicant has amended the claims to include a structural relationship between the valve shield thickness t and the valve guide thickness T that is found in originally allowed Claim 10 and in the specification as originally filed, and that is not taught or suggested by the combination of Ito and Matthews (the References).

In view of the foregoing amendments and remarks, Applicant submits that the References do not teach or suggest each and every element of the claimed invention and disclose a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. § 103(a) has been traversed, and requests that the Examiner reconsider and withdraw this rejection.

Applicant has amended the claims for presentation in a better form that more clearly reflects Applicant's invention. The claim amendments should only require a cursory review by the Examiner as they include language presented in earlier allowed claims.

In light of the foregoing remarks and amendments, Applicant respectfully submits that the proposed amendments and arguments comply with 37 C.F.R. § 1.116 and should therefore be entered, and with their entry that the Examiner's rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) have been traversed, and that the application is now in condition for allowance. Such action is therefore respectfully requested.

Appn. No. 10/691,364
Docket No. GP-303400/GM2-0068

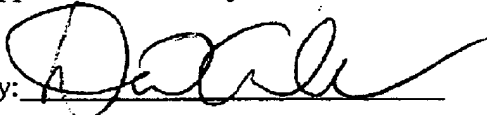
The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 06-1130.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above identified Deposit Account.

Respectfully submitted,

CANTOR COLBURN LLP

Applicant's Attorneys

By: 

David Arnold
Registration No: 48,894
Customer No. 23413

Address: 55 Griffin Road South, Bloomfield, Connecticut 06002
Telephone: (860) 286-2929
Fax: (860) 286-0115